REMARKS

In the Office Action dated December 20, 2005, claim 1 was rejected under 35 U.S.C. §102(e) as being anticipated by Kubatzki et al (European Application 0 805 419). This is rejection is respectfully traversed for the following reasons.

The Examiner has acknowledged that the Kubatzki et al reference does not explicitly teach a switchover module, but the Examiner stated that since the structure recited in the reference is substantially identical to that of the claims, the claimed property or functions are presumed to be inherent. For substantiation for this conclusion, the Examiner cited MPEP Section 2112.01.

Not only is MPEP Section 2112.01 completely inapplicable to the present situation, but also Applicant submits that the Examiner has completely failed to provide a proper factual substantiation for an inherency argument in general.

Addressing first the Examiner's reliance on MPEP Section 2112.01, that section is primarily intended to apply to chemical compositions and situations analogous thereto, and has no applicability to the present situation, because Applicant is not relying on a function or characteristic in the subject matter of claim 1 as a basis for patentability, but is relying on the *structure* explicitly set forth in the language of claim 1. MPEP Section 2112.01 is intended to apply to the situation that most commonly arises in the examination of patent claims directed to a chemical product, wherein the Examiner is able to demonstrate that the atomic or molecular structure of the claimed product exists in the prior art, but the prior art does not describe a particular property or characteristic of the chemical composition in question. The burden then shifts to the Applicant to demonstrate that, despite the claimed chemical having the same or a very similar composition to a chemical in the

prior art, the function or characteristic of the claimed subject matter that is relied upon for patentability did not exist with respect to the prior art composition. This concept is completely inapplicable to the present situation, wherein the *structure* set forth in claim 1 can easily be compared with the *structure* set forth in the Kubatzki et al reference. The structural elements of the claim either are present, or not present, in the Kubatzki et al reference, and there is no need to investigate properties or functions of either the claimed subject matter or the subject matter disclosed in the Kubatzki et al reference.

As to the inapplicability of the concept of inherency in general with regard to claim 1 and the Kubatzki et al reference, Applicant respectfully submits that the Examiner has completely failed to provide any factual evidence whatsoever of the type required by MPEP Section 2112. As noted at the very beginning of MPEP Section 2112, whether a prior art reference includes an inherent teaching is a question of fact, *In Re Napier,* 55 F.3d 610, 613, 34 U.S.P.Q. 2nd, 1782, 1784 (Fed. Cir. 1995).

Section IV of MPEP Section 2122, in a capitalized, bold face heading, requires the Examiner to provide a rational or evidence tending to show inherency. That Section further states that the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic, *In Re Rijckaert,* 9 F 3rd 1531, 1534, 28 U.S.P.Q. 2nd 1955, 1957 (Fed. Cir. 1993) and *in Re Oelrich*, 666 F.2d 578, 581--82, 212 U.S.P.Q. 323, 326 (CCPA 1981).

The mere fact that a certain thing may result from a given set of circumstances is not sufficient, *In Re Robertson*, 169 F.3d, 743, 745, 49 U.S.P.Q. 2d 1949, 1950-51 (Fed. Cir. 1999).

In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* follows from the teachings of the applied prior art, Ex Parte Levy, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In an effort to substantiate the Examiner's position that the Kubatzki et al reference inherently discloses a switchover module, the Examiner has provided a number of column and line citations, however, none of those citations even remotely describes anything that could be considered as a "switchover module." If the Examiner in fact believes that a switchover module is disclosed anywhere in the Kubatzki et al reference, the Examiner is requested either to specifically underline a phrase or term that the Examiner believes describes a "switchover module," or to circle a component or element or method steps in any of the drawings of the Kubatzki et al reference that the Examiner believes inherently represents, or encompasses, a "switchover module." In the absence of such a demonstration by the Examiner, Applicant respectfully submits that there is no explicit or inherent disclosure anywhere in the Kubatzki et al reference of a "switchover module," having either the structure or manner of operation as set forth in claim 1. In fact, as demonstrated below, the Kubatzki et al reference includes numerous explicit statements and teachings that expressly contradict any conclusion that the Kubatzki et al reference has such a "switchover module, inherently or otherwise."

As set forth in claim 1, the switchover module is connected *between* the postage meter, the scale and the modem, and has a control line for setting a switching state of the switchover module to produce a serial connection between the external source and the postage calculator. The external source is explicitly stated in claim 1 to be a source of rate table data, and to be something other than the postage meter. The aforementioned serial connection serially conducts a table data, during downloading thereof, directly from the external source to the postage calculator *exclusively* via the modem and the switchover module.

As is clearly shown in Figure 1 of the Kubatzki et al reference, the postage meter machine FM has a direct connection 17 from the data central DC, which is the source of rate table data. Therefore, it is clear that any rate table data from the data central DC in the Kubatzki et al reference must necessarily pass *through* the postage meter machine FM, which is exactly the situation that claim 1 avoids.

This is also made explicitly clear in Figure 2 of the Kubatzki et al reference, during the connection 1 is shown directly leading from the data center DC to the modem 23 *of the postage meter machine*. The description of Figure 2 in the "description of the drawings" section of the Kubatzki et al reference makes clear that everything shown in Figure 2 is part of the postage meter machine. The same is true for the alternative embodiment shown in Figure 4a.

Figure 3 is explicitly stated to be a flowchart describing operation of the *postage meter machine* with *integrated* postage calculation. This makes clear that, directly contrary to claim 1 of the present application, the postage calculator is *integrated* into the postage meter machine, rather than in an external scale that is *connected to* the postage meter machine. Figure 3, in the communication mode 300,

explicitly states that communication is initiated with the data central, transactions are executed, and credit and other data are reloaded. Again, this is a procedure taking place *in the postage meter machine*, as explicitly stated in the Kubatzki et al reference.

The same is true of the communication mode 300 in the embodiment of the flow chart shown in Figure 4d of the Kubatzki et al reference.

These statements in the Kubatzki et al reference make explicitly clear that the Kubatzki et al reference not only has no switchover module, but in fact is designed to operate with rate table data being downloaded *through* the postage meter machine, exactly the situation that the subject matter of claim 1 avoids.

Claim 1, therefore, is not anticipated by Kubatzki et al.

Claims 2-4, 6-12 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kubatzki et al, Simionescu et al and Brookner et al. This rejection is respectfully traversed for the following reasons.

First, as noted above, the Kubatzki et al reference explicitly teaches that all data downloaded from the data center must proceed *through* the postage meter machine. Modifying the Kubatzki et al system so that the downloading of data does *not* proceed through the postage meter machine would be a complete redesign of that postage meter machine, as well as a substantial shift in the underlying operating concept thereof, and as such would not be an obvious modification of the type that justifies a rejection under 35 U.S.C. §103(a), but in fact constitutes a reason against making such a modification.

Moreover, the Examiner has stated that a motivation to combine the teachings of those references would be to work around a "known bottleneck" in the computer

data download process, but the Examiner has not cited a teaching in any of the Kubatzki et al, Simionescu et al or Brookner et al references that mentions such a bottleneck problem, and therefore none of those references provides any solution to solving such a bottleneck problem. It is telling that after using the word "bottleneck" at page 5 of the Office Action, in connection with the alleged motivation, the word bottleneck does not occur in any of the subsequent *ten pages* wherein the Examiner provides extensive citations to the Simionescu et al and Brookner et al references to substantiate these rejections. If one or both of those references truly provided any solution to solving some type of "bottleneck" problem it seems that in *ten pages* of text, the Examiner should somewhere be able to identify the use of that word or a description of the problem in those references.

This was extensively discussed in Applicant's response, filed September 1, 2005, to the last Office Action, wherein the Simionescu et al and Brookner et al references also were relied upon by the Examiner.

These arguments are set forth on pages 8 through 10 of Applicant's last response, and need not be repeated verbatim herein. It is sufficient to state that in the Brookner et al reference, there is *no capability* of communicating with an external data source, and therefore *no capability* of participating in any serially conducted data download from such an external source to another device. The postage meter 1 disclosed in the Brookner et al reference is not even schematically indicated as having any type of external communication capability. In the last Office Action, the Examiner did not even comment on these basic, fundamental failings of the Brookner et al reference, but simply repeated the previous (incorrect) correlation of the operation of the Brookner et al reference with the subject matter of claim 1.

As also argued in Applicant's previous response, the Simionescu et al reference, although a serially-operating device, does not provide any discussion whatsoever of a "bottleneck" problem between an external data source and a postage calculator, and therefore a person of ordinary skill seeking (for whatever reason) to modify the Kubatzki et al reference would not find any discussion in either of the those references that such a problem even exists, and therefore it is impossible for such a person to obtain any guidance to solving that problem from either of those references. Simply because the Simionescu et al reference makes use of a serially-operating device does not mean that the serially-operating device was used therein to alleviate any type of bottleneck. Instead, as explicitly stated in the Simionescu et al reference, the use of the serially-operating device is for the purpose of allowing *testing* to be undertaken, via an emulator processor, without significantly affecting the normal operation of the microprocessor itself. For this purpose, software and hardware in the main microprocessor are bypassed, but this is explicitly stated in Simionescu et al to be accomplished by using bypass *software* that is downloaded into the memory 1202 prior to testing (column 19, lines 25-29). Therefore, even if this situation can be considered as "bypassing a bottleneck" (which Applicant doubts), such bypassing is undertaking by *software* rather than by physically switching a switchover module, as disclosed and claimed in the present application. Moreover, as noted above, even if the situation described in Simionescu et al can be considered to be some type of "bypassing," this has nothing whatsoever to do with downloading data from an external source. As can clearly be seen in Figure 12 of the Simionescu et al reference, the emulator processor is connected between the main processor and the I/O port, and therefore the Simionescu

processor is physically incapable, by software or otherwise of alleviating any "bottleneck" problem relating to downloading of data an external source to a postage calculator.

If the Examiner intends to maintain this rejection, the Examiner is respectfully requested to at least provide a minimal response to these arguments, that go to the fundamental basis of operation of each of the Brookner et al and Simionescu et al references. These fundamental lacking teachings in Brookner et al and Simionescu et al completely undermine the theory of the Examiner as to the manner of the operation of those devices, as well as the Examiner's contention that either of those devices (even if the Examiner's theory of their operation is correct) would be a source of guidance to a person of ordinary skill in the field of postage meter design as a basis for modifying the Kubatzki et al reference to alleviate the aforementioned bottleneck problem.

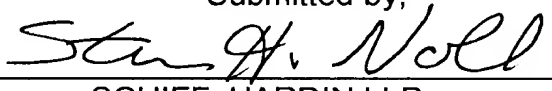
In the absence of any refutation by the Examiner of these previously-made arguments, Applicant submits that none of claims 2-4, 6-12 or 14 would have been obvious to a person of ordinary skill in the field of postage meter design under the provisions of 35 U.S.C. §103(a) based on the teachings of Kubatzki et al, Simionescu et al and Brookner et al.

Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kubatzki et al, Simionescu et al and Brookner et al, further in view of Rothstein. Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over the Kubatzki et al/ Simionescu et al/Brookner et al combination, further in view of Ezzet et al.

For the reasons noted above, Applicant completely disagrees that the Kubatzki et al/ Simionescu et al/Brookner et al combination is in anyway applicable, relevant or correctly analyzed with regard to independent claim 1 and the claims depending therefrom. Therefore, even if the Examiner's statements with regard to the Rothstein and Ezzet et al references are accurate, modifying the Kubatzki et al/ Simionescu et al/Brookner et al combination in accordance with the teachings of either of those references would not result in the subject matter of either of claims 5 or 13, nor would such a modification have been obvious to a person of ordinary skill in the field of postage meter design.

All claims of the application are therefore submitted to be in condition for allowance, and early reconsideration of the application is respectfully requested.

Submitted by,



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